



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/589,070 | 03/31/2008 | Hakan Thysell | 65954(54755) | 5869 |
| 21874 7590 02/17/2009 EDWARDS ANGELL PALMER & DODGE LLP P.O. BOX 55874 BOSTON, MA 02205 | | | | |
| EXAMINER RACHUBA, MAURINA T | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3727 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 02/17/2009 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/589,070

Applicant(s)

THYSELL, HAKAN

Examiner

Maurina Rachuba

Art Unit

3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-54 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 22-54 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 10 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 8/10/06
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Inventor's Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 41-45 and 52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 41 limits "a second finishing unit tiltable about a second axis that is substantially parallel to the central axis of the finishing machine, and a third finishing unit tiltable about a third axis, wherein the second axis and the third axis are configured to form an acute angle". This is new matter. While applicant has disclosed an embodiment where the second and third axes form an acute angle, there is no disclosure that the second angle is parallel with the central axis of the machine. The embodiment disclosed has both axes at an angle to the central axis of the machine. Claim 52 limits the frequency converters to providing power to the propelling unit and finishing units, however, as disclosed, see page 14, the converters do not supply power as claimed, but individually control the speed of the drive wheels 200 and the finishing units. (note that in line 24, 200 refers to drive wheels, where it should refer to drive motor).

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 52 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 52 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the relationship between the engine and generator with the frequency converters. As disclosed, the converters do not supply power to the finishing units and propelling unit, the converters control the speed of the drive wheels and finishing units. As such, the scope of this claim cannot be readily determined.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 22-40, 46-51 and 53 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Palushi, 7,261,623. '623 discloses the claimed invention. Please refer to figures 29-34, and column 12, lines 5 through column 14, lines 51. Note that the finishing units have been defined as having motor driven finishing elements in the form

of discs, see figure 3. Regarding claim 53, '623 discloses at least one drive wheel and at least one pivot (caster) wheel, see column 12, lines 12-22 and lines 66-67. Caster is defined as "any of a set of wheels or rotating balls mounted in a swivel frame and used for the support and movement of furniture, trucks, and portable equipment"¹.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 41-43, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palushi, 7,261,623. Regarding claim 41, '623 discloses the claimed invention does not disclose the claimed orientation of the third unit. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided '623 with a third unit positioned such that it is tiltable about an axis that forms an acute angle with the second unit, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Here, one of ordinary skill would have found it obvious to have positioned the second and third units as claimed, for the predictable result of narrowing the footprint of the apparatus.

9. Claims 29 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palushi, 7,261,623 in view of Legatt, 6,450,867. '623 does not disclose each of the

¹ Merriam-Webster Online Dictionary copyright © 2009 by Merriam-Webster, Incorporated

finishing units provided with an actuating mechanism for adjusting a degree of tilting of the unit relative to the frame. In a similar apparatus, '867 teaches that it is old and well known to provide a finishing unit of a surface treating device with an actuating mechanism for adjusting a degree of tilting of the unit relative to the frame of the device. It would have been obvious to one of ordinary skill in the art to have provided '623 with the actuator taught by '867, column 7, lines 9 through column 8, lines 20, for the predictable result of controlling the degree of tilting of the units.

10. Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Palushi, 7,261,623 in view of Brogden, 5,070,656 and Langer, 5,581,863. '623 does not disclose that the finishing tool comprises an internal combustion engine, a generator, and frequency converters to supply power to the propelling units and finishing units. In a similar apparatus, '656, teaches driving a finishing unit with a fork lift truck that is powered by an internal combustion engine and a generator to provide electric power to drive the truck, and the finishing unit, see column 2, lines 40 through column 3, lines 36, allowing the production of electrical energy. It would have been obvious to one of ordinary skill in the art to have provided '623 with the engine and generator of '656, for the predictable result of driving the finishing units and propelling unit. Regarding the use of frequency converters, '623 does not disclose the use of such to power the finishing or propelling units. '863, in a device for driving a plurality of individual machining devices, teaches that it is old and well known to use frequency converters with an electrical generator to control the speed of each individual motor. It would have been obvious to one of ordinary skill in the art to have provided '623 with the frequency

converters taught by '863, column 2, lines 10-29 for the predictable result of controlling individual motors simultaneously.

11. Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Palushi, 7,261,623 in view of Beckett et al, 5,643,047. '623 does not disclose the use of an image-generating device operably connected to the machine for inspecting the work surface in real time. Please note that the term "image-generating device" is extremely broad in scope. As such, in a similar device, '047, column 3, lines 16-26, teaches the use of an image-generating device in the form of a plotting device that with the controlling computer provide real time graphing of the work surface as compared to a preprogrammed surface contour. It would have been obvious to one of ordinary skill in the art to have provided '623 with the image-generating device of '047, for the predictable result of monitoring the surface in real time.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Other similar devices are cited of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurina Rachuba whose telephone number is 571 272 4493. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571 272 4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Rachuba/
Primary Examiner, Art Unit 3727